

REMARKS

Claims 1 through 8 and 10 through 16 are currently pending in the application.

This amendment is in response to the Office Action of August 24, 2004.

Information Disclosure Statement(s)

Applicants note the filing of an Information Disclosure Statement herein on August 4, 2003 and note that a copy of the PTO-1449 pages 2, 3 and 4 were not returned with the outstanding Office Action. Applicants respectfully request that the information cited on the PTO-1449 pages 2, 3 and 4 (which is the same as that of record to that date in the parent application hereto) be made of record herein. A copy of the as-filed IDS and PTO-1449 along with the PTO date-stamped postcard is attached.

Preliminary Amendment

Applicants note the filing of a Preliminary Amendment on March 4, 2004, which filing was not acknowledged in the outstanding Office Action. Should the Preliminary Amendment have failed to have been entered in the Office file, Applicants will provide a true copy to the Examiner.

35 U.S.C. § 101 Double Patenting Rejection

Claims 1 through 8 and 10 through 16 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1 through 16 of prior U.S. Patent 6,616,880 (hereinafter referred to as the '880 patent), and claims 1 through 17 of U.S. Patent 6,287,503 (hereinafter referred to as the '503 patent). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicant asserts that a reliable test for statutory double patenting under 35 U.S.C. § 101 is whether a claim in the application can be literally infringed without literally infringing a corresponding claim in the patent. Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting under 35 U.S.C. § 101 does not exist. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

Applicant asserts that no statutory double patenting under 35 U.S.C. § 101 exists between the embodiments of the inventions set forth in presently amended independent claims 1 and 8 of the present application and the embodiments of the inventions set forth in corresponding independent claims 1 and 8 of the '880 patent and corresponding independent claims 1 and 9 of the '503 patent because different embodiments of the inventions are being claimed. For instance, the embodiments of the inventions set forth in presently amended independent claims 1 and 8 of the present application do not include the various providing elements of the inventions and do not include the claim limitation calling for encapsulation of an electronic component on the first side of the first substrate and the first side of the second substrate whereas the embodiments of the inventions set forth in corresponding independent claims 1 and 8 of the '880 patent and the embodiments of the inventions set forth in corresponding claims 1 and 9 of the '503 patent do elements of the inventions and claim limitations. Accordingly, no statutory double patenting exists between the embodiments of the inventions set forth in presently amended independent claims 1 and 8 of the present application and the embodiments of the inventions set forth in corresponding independent claims 1 and 8 of the '880 patent and the embodiments of the inventions set forth in corresponding independent claims 1 and 9 of the '503 patent.

Therefore, presently amended independent claims 1 and 8 as well as dependent claims 2 through 7 and 10 through 16 therefrom are allowable.

Applicants submit that claims 1 through 8 and 10 through 16 are clearly allowable.

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Applicants request the allowance of claims 1 through 8 and 10 through 16 and the case passed for issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "James R. Duzan".

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